

IV. REMARKS

Status of the Claims

Claims 1, 5, 13 and 16 are amended, claim 14 is cancelled. Claims 1-13 and 15-20 are presented for further consideration.

Summary of the Office Action

Claims 1-20 stand rejected under 35USC102(e) on the basis of the cited reference Turunen (WO 99/61966). The Examiner is respectfully requested to reconsider his rejection in view of the above amendments and the following remarks.

The Invention

Independent claims 1, 13, 16, 17, 19, and 20 define a method, server, network element, system and computer programs for inquiring about information relating to a wireless terminal of a cellular network by a messaging server. An inquiry sent by the server comprises a first identifier which is, in the cellular network, mapped to a second identifier. The first identifier is an identifier external to the cellular network and the second identifier is an internal identifier of the cellular network. Said information, relating to the wireless terminal, is determined with the aid of said second identifier and sent to the server with the aid of said first identifier. By this use of identifiers advantages described on page 19, lines 5-20 of the present application can be achieved.

Discussion of the Cited Reference

The Examiner has cited the reference Turunen in support of the rejection based on anticipation. In particular the passage as follows:

"This examination can be conducted for example in such way that the e-mail server MSV transmits a query message to a name server DNS attached to the GPRS system. If the wireless terminal MS1 of the recipient is connected to the GPRS network PLMN, and has an active packet data connection, the name server DNS transmits to the e-mail server an acknowledgement message, with which it indicates the IP address of the wireless terminal MS1 of the user. If the wireless terminal MS1 of the user is not connected to the GPRS network at that moment, the e-mail server MSV transmits the query message again later. If a static IP address is determined in the wireless terminal MS1 of the recipient, the e-mail server MSV can transmit IP query packets to this IP address, wherein the wireless terminal MS1 of the recipient transmits an acknowledgement message to the e-mail server MSV. If no acknowledgement message is received, e-mail messages cannot be transmitted to the wireless terminal MS1 of the recipient at that moment."

A review of this passage reveals that it does not focus on identifiers, but refers only to a "static IP address". There is no further mention of identifiers. This is quite different than the subject method and system in which a first identifier external to a cellular network is mapped to a second identifier used in the cellular network. Applicant submits therefore, that the cited reference fails to support the rejection based on anticipation.

The Issue of Anticipation

It is well settled that a claim is anticipated, "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (See CHISOLM, Federal Circuit Guide, Pg. 1221).

The elements of the claim and their function and purpose within the claim must be reviewed in a manner similar to an infringement analysis. If the device described in the cited reference would not infringe if it was later, it will not anticipate if the reference is earlier.

Applying this standard to the system of the reference Turunen, it becomes clear that the system of Turunen is missing significant elements of the independent claims. Claim 1 states:

"sending an inquiry from the messaging server to the cellular network to determine said information relating to the terminal, the inquiry comprising a first identifying said terminal, the first identifier being a specific identifier external to the cellular network;

mapping said first identifier to a specific second identifier in the cellular network, the second identifier being an internal identifier of the cellular network;

determining said information relating to the terminal with the aid of said second identifier;"

Equivalent language also is contained in claims 13, 16, 17, 19 , and 20. Since these elements form no part of the system of Turunen, there would be no infringement, if Turunen was later, therefore, the cited reference does not support the rejection by the Examiner based on anticipation.

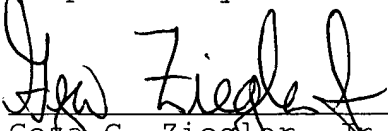
The above arguments are equally applicable to the rejected dependent claims.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should

any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,


Gera C. Ziegler, Jr.
Reg. No. 44,004

23 September 2004
Date

Perman & Green, LLP
425 Post Road
Fairfield, CT 06824
(203) 259-1800
Customer No.: 2512

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date indicated below as first class mail in an envelope addressed to ~~the~~ Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450. MAIL STOP AMENDMENT,

Date: 9/23/04

Signature: 
Person Making Deposit